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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,629	11/25/2003	Richard L. Rudolph	AHP92021 D6	7720

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EXAMINER	
RAMACHANDRAN, UMAMAHESWARI	
ART UNIT	PAPER NUMBER
1617	

MAIL DATE	DELIVERY MODE
04/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/721,629	Applicant(s) RUDOLPH ET AL.	
	Examiner UMAMAHESWARI RAMACHANDRAN	Art Unit 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-7 and 9-14*.
   Claim(s) withdrawn from consideration: *8*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617

Note: Applicants' arguments and remarks regarding the 112(1) and 103 rejections have been fully considered and found not to be persuasive. The claims are still not allowable over the prior art teachings cited in the final rejection.

Applicants' argue that that one skilled in the art, with Applicants disclosure before him or her, would be able to practice the claimed invention without undue experimentation and cite Pope et al.'s teachings where a variety of antidepressants are shown to be useful for the treatment of bulimia. In response, Applicants' have not shown or provided any data to state that the compounds of the instant application have similar pharmacological property (e.g. enzyme inhibitor) or does not state that they are all antidepressants. Applicants state the properties of venlafaxine as antidepressant. The compounds claimed are structurally related to venlafaxine but it would have not been obvious to one of ordinary skill in the art at the time of the invention that they are antidepressants or have similar pharmacological profiles. Accordingly, one of ordinary skill in the art would have not been able to predict the claimed compounds to be antidepressant just looking at the structures and then predict from Pope et al.'s teachings that those compounds will be useful in treating bulimia.

Applicants' argue that the medical treatment arts are highly unpredictable, different antidepressants act via different mechanisms and one cannot predict whether or how a given antidepresssant will work and hence claims 1-5, 7 and 9-13 are not rendered obvious in light of Pope et al. in view of Schweizer et al. In response, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties. See, e.g., In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). As stated in the rejections, Pope et al teaches the benefits of antidepressants in the treatment of bulimia and state that phenelzine, an antidepressant significantly improved the frequency of binge eating. Schweizer et al. teach venlafaxine as an effective antidepressant. One having ordinary skill in the art at the time of the invention would have been motivated to administer venlafaxine for another antidepressant in a method of treatment of bulimia from Pope et al's teachings in expectation of success, as an alternative therapy and to achieve similar or superior therapeutic benefits compared to other antidepressants.

Applicants' argue that claim 6 does not relate to stereo selectivity but rather defines the position of R5 and R6 on the phenyl ring relative to the point of attachment. In response, Wang has been cited to show that different isomers of venlafaxine can be separated and the disposition of venlafaxine enantiomers in humans is not stereoselective. Hence one of ordinary skill in the art would have been able to obtain isomers with respect to substituents in R5 and R6 positions as claimed to use in a method of treating bulimia.

Applicants' argue that Edgren et al. teaches controlled release usage forms and does not teach the use of venlafaxine for the treatment of bulimia. In response, Edgren has been cited to show that venlafaxine is useful as in antidepressant therapy.

Accordingly, the rejections are proper and are maintained